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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,617	03/09/2004	Geoffrey B. Rhoads	P0950	4084
23735 7590 10/28/2009 DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008				
EXAMINER				
ALLISON, ANDRAE S				
ART UNIT		PAPER NUMBER		
2624				
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10/28/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/797,617

Applicant(s)

RHOADS ET AL.

Examiner

ANDRAE S. ALLISON

Art Unit

2624

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment filed 09 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8, 10, 11 amd 15-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 10, 11 amd 15-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Remarks

1. The Office Action has been made issued in response to amendment filed July 9, 2009. Claims 1-6, 8, 10-11 and 15 -23 are pending. Applicant's arguments have been carefully and respectfully considered in light of the instant amendment, and are not persuasive. Accordingly, this action has been made **FINAL**.

Interference

Applicant has not submitted a claim Chart showing written description support in Applicant's specification as required by 37 CFR 41.202 (a)(5); however, the priority document Applicant is relying upon does not provide support for all the claim limitations. For claim 1, Applicant pointed to sections of priority patent document 5,862,260 filed May 16, 1996. For the limitation "subjected to geometric transformation", Applicant pointed to column 72, line 66 to column 73, line 3; however this portion of the patent does not describe subjecting to geometric transformation. In fact, this section subheading states reads "methods for embedding subliminal registrations patterns into images and other signals", which means that this section has nothing to do with subjecting to geometric transformation and cited section teaches given a signal with a embedded with a subliminal digital graticule, then it is possible to find the scale, rotation or origin of the subliminal digital graticule. For the limitation "detection registration signals form said inputted image data to perform registration processing", Applicant cited Figs

37, Fig 33-36 and column 78, lines 13 to column 77, line 30. While it seem that the cited portion teaches "detection registration signals", "detection registration signals form said inputted image data to perform registration processing" is not taught by the patent. Furthermore, in column 77, lines 23-25, Applicant stated that the inventor has not reduced the method of Fig 36 which Applicant is relying upon. Claims 8, 10 and 11 are similar to claim 1, so see the discussion above for these claims.

Claim Rejections – 35 USC section § 102

Since Applicant has not complied with the conditions for receiving the benefit of the claimed priority filing date(s) because the disclosure is not sufficient to comply with the requirements of 35 U.S.C. § 112, first paragraph. Therefore, the effective filing date for the invention defined by claims 1-6, 8 and 10-11 is 09 March 2004, and Hayashi et al. '758 qualifies as prior art under 35 U.S.C. § 102(e).

Claim Rejections – Double Patenting

Applicant argues that performing logarithmic sampling of the media signal" does not require a transform of the median signal into a frequency domain, the Examiner agrees. However, this shows that patent '725 anticipates the present claims. Therefore the rejection is not withdrawn.

Interference

2. Applicant has indicated that the claims in this application were copied from US PGPUB 2001/0055390 (see "Notice of Copied Claims" filed 09 March 2004). However Applicant has not submitted a claim Chart showing written description support in Applicant's specification as required by 37 CFR 41.202 (a)(5).

Priority

3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120 as follows: The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. § 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The legal criteria for the "written description" requirement is laid out in M.P.E.P. § 2163, as well as the *Guidelines for Examiner of Patent Applications Under the 35 U.S.C. § 112, first paragraph, "Written Description" Requirement*, published in the Federal Register, Vol. 66, No. 4, January 5, 2001.

"[T]he test for sufficiency of support...is whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575; 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d

1366, 1375; 217 USPQ 1089, 1096 (Fed. Cir. 1983)). "Although [the applicant] does not have to describe exactly the subject matter claimed,...the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." *Vas-Cath*, 19 USPQ2d at 1116 (quoting *Gostelli*, 872 F.2d 1008, 1012; 10 USPQ2d 1614, 1618 (Fed. Cir. 1989)). It is "not a question of whether one skilled in the art might be able to construct the patentee's device from the teachings of the disclosure...Rather, it is a question whether the application necessarily discloses that particular device." (*Jepson v. Coleman*, 314 F.2d 533, 536; 136 USPQ 647, 649-50 (CCPA 1963)). "The question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification. Rather, [the] application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought" *Lockwood v. American Airlines Inc.* 41 USPQ2d 1961 at 1966 (Fed. Cir. 1997).

The claims in the instant application variously include limitations that are not described in the priority application(s)¹, as originally filed, in sufficient detail that one skilled in the art can clearly conclude that applicant invented the application as of the filing date of the priority application(s). Specifically claim 1 requires a geometric transforming step of performing inverse transformation of said identified geometric transformation. However, the disclosure in the priority documents does not describe a geometric transforming step of performing inverse transformation of said identified

¹ i.e., Application S.N. 08/512,993 filed 09 August 1995, which applicant has pointed to as providing support for the invention now claimed. The specification of the '993 application, as well as the intervening applications is substantially identical to the specification of the instant application. However, the subject

geometric transformation. The specification does state that once the orientation parameters, i.e. geometric transformations, are found, a reader can reorient the target image before extracting, but there is no specific discussion as to how this re-orientation is done.

Furthermore, a number of the dependent claims include additional limitations that are likewise not adequately described by the disclosure. Specifically, claim 4 requires said frequency transforming step, Fourier transformation is performed, and conversion into amplitude spectra of said frequency components is made. The specification does disclose a Fourier transformation is performed, however, does not describe wherein conversion into amplitude spectra of said frequency components is made. Similarly while the disclosure does discuss a block dividing step of dividing said image data into at least one blocks, there is not discussion of block synthesizing step of combining blocks divided by said block dividing step to reconstruct the image as required by claim 6. Because none of these additional limitations is described in the specification, the disclosure, as originally filed in the priority application(s), fails to adequately show that applicant possessed the invention now claimed at the time the various priority documents were filed.

While a number of the claimed limitations might have been obvious to one of ordinary skill in the art, this is not sufficient to demonstrate possession of the claimed invention because these limitations are not *necessarily* required by the disclosure in the priority application(s). "One shows that one is 'in possession' of *the invention* by

matter of the instant claims has not been presented prior to the presentation of the instant claims on the

describing *the invention*, with all its claimed limitations, not that which makes it obvious." *Lockwood v. American Airlines Inc.* 41 USPQ2d 1961 at 1966 (Fed. Cir. 1997) (emphasis in original). Although the invention is not required to be described using the exact same terms, "the specification must contain an equivalent description of the claimed subject matter. A description which renders obvious the invention for which an earlier filing date is sought is not sufficient." *Lockwood v. American Airlines Inc.* 41 USPQ2d 1961 at 1966 (Fed. Cir. 1997). "It is not sufficient for purposes of the written description requirement of Section 112 that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose. Each application in the chain must describe the claimed features." *Lockwood v. American Airlines Inc.* 41 USPQ2d 1961 at 1966 (Fed. Cir. 1997). Since the priority application(s) do not describe or necessarily require the various claim limitations addressed in more detail above, the priority application(s) do not adequately describe the invention, as now claimed, so that one of ordinary skill in the art would recognize that applicant was in possession of the claimed invention as of the filing date(s) of these priority application(s). Therefore, the claimed invention is only entitled to the filing date of the instant application, where these claims were first presented (i.e., 09 March 2004).

Claim Rejections - 35 U.S.C. § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6, 8 and 10-11 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Hayashi et al. '758 (US 6,741,758 B1).

As pointed out more fully above, applicant has not complied with the conditions for receiving the benefit of the claimed priority filing date(s) because the disclosure is not sufficient to comply with the requirements of 35 U.S.C. § 112, first paragraph. Therefore, the effective filing date for the invention defined by claims 1-6, 8 and 10-11 is 09 March 2004, and Hayashi et al. '758 qualifies as prior art under 35 U.S.C. § 102(e). Furthermore, because claims 1-6, 8 and 10-11 of the instant application were specifically identified by applicant as corresponding identically to claims 1-6, 8 and 10-11 of Hayashi et al. '758 the instant claims are clearly anticipated by Hayashi et al. '758.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 15 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,424,725. The conflicting claims are not identical because patent claim 15 requires the additional step of "detecting an embedded signal in the frequency component", which is inherent feature in claim 1. However, the conflicting claims are not patentably distinct from each other because:

- Claims 1 and 15 recite common subject matter;
- Whereby claim 1, which recites the open ended transitional phrase "comprising", does not preclude the additional elements recited by claim 15, and
- Whereby the elements of claim 1 are fully anticipated by patent claim 15, and anticipation is "the ultimate or epitome of obviousness" (*In re Kalm*, 154 USPQ 10 (CCPA 1967), also *In re Dailey*, 178 USPQ 293 (CCPA 1973) and *In re Pearson*, 181 USPQ 641 (CCPA 1974)).

A signal processing method for determining a geometric transformation applied to a media signal, the method comprising: transforming the media signal into a frequency domain to produce frequency components of the media signal; detecting an embedded signal in the frequency components; based on the detecting, determining geometric transformation parameters defining a geometric transformation of the media signal; and using the geometric transformation parameters to transform the media signal.	1. A method of determining a transformation of a media signal having an embedded code signal, the method comprising: performing a logarithmic sampling of the media signal to create a sampled signal in which scaling of the media signal is converted to translation in the sampled signal; and computing translation of the embedded code signal in the sampled signal to determine scaling of the media signal subsequent to the encoding of the embedded signal in the media signal...:
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Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquires

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDRAE S. ALLISON whose telephone number is (571)270-1052. The examiner can normally be reached on Monday-Friday, 8:00 am - 5:00 pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vikkram Bali can be reached on (571) 272-7415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. S. A./
Examiner, Art Unit 2624

/Anand Bhatnagar/
Primary Examiner, Art Unit 2624
October 26, 2009